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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,967	10/24/2003	Robert Garrett	GARR-0009	6974

21261 7590 05/03/2007  
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EXAMINER
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BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/691,967	<b>Applicant(s)</b> GARRETT, ROBERT	
	<b>Examiner</b> Carolyn T. Blake	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 14-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the amendment and remarks filed on December 11, 2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

3. Claims 5 and 18 are objected to because of the following informalities: It appears the claim should read - -four-tooth blade- - instead of "four-bladed blade" (line 2). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 14-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation requiring "installing roofing material to a roof such that at least a portion of the roofing material extends beyond a desired portion of the roof, and cutting the roofing material extending beyond the desired portion of the roof" (claims 14, lines 3-5) constitutes new matter because it was not set forth in the original disclosure.

***Claim Rejections - 35 USC § 103***

6. Claims 1, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al (4,685,214) in view of Zimmerman (4,561,477).

Shearon et al disclose a saw substantially as claimed, including: an air motor (22) for receiving compressed air and driving a rotary shaft (32); a saw blade (42), coupled to the rotary housing; and a saw housing (224), adjustably coupled to the air motor (22), for controlling a depth of cut of the saw blade (42). The Shearon et al device is capable of cutting roofing shingles as claimed.

Shearon et al fail to disclose carbide tips on the blade. However, Zimmerman discloses a saw blade with carbide bits (52). The addition of carbide to a blade retains the cutting sharpness for a longer period of time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Shearon et al blade with carbide bits, as disclosed by Zimmerman, for the purpose of retaining blade sharpness.

Regarding claim 8, Shearon et al fail to disclose the blade thickness. Zimmerman discloses a blade that is 0.25 inches thick (col. 4, lines 58-59). In addition, it would have been obvious to make a blade with the thickness claimed in order to cut through a work piece easily with minimal blade deflection or deformation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Shearon et al blade 0.25 inches thick in order to cut through a work piece easily with minimal blade deflection or deformation.

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7. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Zimmerman as applied to claim 1 above and in further view of Lee (1,955,137).

The modified Shearon et al device teaches the blade (42) has 4 to 8 teeth, but fails to disclose the diameter of the blade. However, Lee discloses a saw blade used to cut shingles (col. 1, line 5) wherein the blade diameter is three inches or greater. In addition, a blade with a diameter within the parameters claimed in order to cut a small item and accommodate mobility would have been obvious to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a blade with a 3-3/8" to 5" diameter, as disclosed by Lee, for the purpose of cutting a small object and accommodating mobility.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Zimmerman as applied to claim 1 above, and further in view of Kelly (5,974,674).

The modified Shearon et al device fails to disclose a grinder motor. However, Kelly discloses a grinder motor for use in a hand-held saw. The grinder motor creates vibration that is useful in cutting thick or hard material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide grinder motor, as disclosed by Kelly, on the modified Shearon et al saw for the purpose of easing a cutting operation.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Zimmerman and Kelly as applied to claim 3 above, and further in view of Barrett et al (5,460,071).

Shearon et al disclose the motor (22) further includes an on-off valve (52) coupled to an activation lever (54), but fails to disclose a safety latch. Barrett et al disclose a safety latch (55) in conjunction with a lever arm (50) and valve (45). The safety latch prevents unwanted actuation of the valve. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a safety latch, as disclosed by Barrett et al, on the modified Shearon et al device for the purpose of preventing unwanted actuation of the valve.

#### ***Response to Arguments***

10. Applicant's arguments filed December 11, 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Shearon et al reference does not teach cutting shingles, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues the Zimmerman reference does not teach a chipper carbide bit. While Applicant may intend for a certain structure to correspond to the phrase "chipper bit," the carbide bit disclosed by Zimmerman would "chip" through a work piece, and thus can be considered a "chipper bit." While the bit of Zimmerman may have a

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different appearance than Applicant's FIG 9, the differences between the bits have not been claimed.

In pages 10 and 11 of the *Remarks*, Applicant argues the 35 USC § 103 rejections should be withdrawn based on long felt need and commercial success. If Applicant would like to argue either of these positions, an affidavit under CFR 1.132 is required.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-

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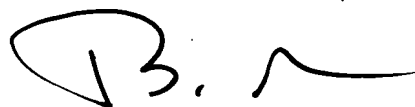
4503. The examiner can normally be reached on Monday to Thursday, 7:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CB

CB  
April 17, 2007



BOYER D. ASHLEY  
SUPERVISORY PATENT EXAMINER